



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,858	02/09/2004	Chia-Shan Wu	722-72	9497

7590 01/05/2006

Yuri Kateshov
DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, NY 11553

EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/774,858

Applicant(s)

WU, CHIA-SHAN

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,7-15,21-23 and 103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on 12/7/05 is acknowledged. The traversal is on the ground(s) that the examination and search of an additional invention would not be a serious burden on the Examiner. This is not found persuasive because searching and examining additional claims to an additional invention clearly is a burden on the Examiner. The claims clearly are additional work and the searching of method steps in addition to structure for an article is clearly another additional burden.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 16-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/7/05.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 7, 9, 10, and 21-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Linnemann (UK 2014034).

Linnemann shows a shoe comprising an upper (14), and outsole (1) with a barrier wall (2), and outsole wall (4), an insole/lining (10), and a sealant/cement (page 1 lines 95-100) as claimed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnemann.

Linnemann discloses the claimed invention except for the exact height and thickness ranges of the barrier wall. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the barrier wall with a height of between 10-20mm and a thickness of between 0.5 and 1.5mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

7. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linnemann in view of either Chen (6412193) or Chen (6115940).

Linnemann shows a shoe substantially as claimed except for the exact type of cement/glue used. Chen '193 or '940 teaches the well known and conventional use of waterproof cements for sole attaching/sealing in the art of waterproof footwear. It would have been obvious to use the well known and conventional waterproof cement as

taught by either Chen '193 or '940 in the footwear of Linnemann to further waterproof the footwear.

8. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linnemann in view of Tiitola (4876807).

Linnemann shows a shoe substantially as claimed except for a midsole element. Tiitola teaches providing an insole/lining (2) and a midsole (9) in a cavity of an outsole (3) with an integral barrier wall (4). It would have been obvious to provide an insole/lining and midsole as taught by Tiitola in the shoe of Linnemann to increase the comfort of the shoe.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 11 and 13 above, and further in view of either Serna (5983529) or McDaniel (2547480).

Linnemann as modified above shows a shoe substantially as claimed except for slits in the midsole. Either Serna or McDaniel teaches providing slits (figure 1B or element 9 or 23) in a midsole layer to increase flexibility. It would have been obvious to provide slits as taught by either Serna or McDaniel in the shoe of Linnemann as modified above to increase flexibility of the sole.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 5 and 14 above, and further in view of Linnemann in view of Tiitola (4876807).

Linnemann as modified above shows a shoe substantially as claimed except for a midsole element. Tiitola teaches providing an insole/lining (2) and a midsole (9) in a

Art Unit: 3728

cavity of an outsole (3) with an integral barrier wall (4). It would have been obvious to provide an insole/lining and midsole as taught by Tiitola in the shoe of Linnemann as modified above to increase the comfort of the shoe.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)272-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson
Primary Examiner
Art Unit 3728